

In re Application of:  
Fenical et al.  
Application No.: 09/991,518  
Filed: November 16, 2001  
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PATENT  
Atty Docket No.: UCSD1630-1

### REMARKS

Claims 20, 30 and 32 have been amended. Claims 2-16, 19, 21-24 and 31 were previously canceled. Subsequent to the entry of the present amendment, claims 1, 17-18, 20 and 25-32 are pending and at issue. These amendments and additions add no new matter as the claim language is fully supported by the specification and original claims.

Applicants and Applicants' representatives gratefully acknowledge the careful consideration of the application and helpful suggestions regarding amendment of the claims made by Examiner Marx in the telephone interview held on December 20, 2005. It is submitted, that at the conclusion of the telephone interview, it was agreed that so long as the claim amendments do not raise new issues and the Declaration of Dr. Jensen includes the statement of averment, that all restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent, the claims should be in condition for allowance. Applicants submit that the response herein satisfies these two conditions and as such is in condition for allowance.

#### **I. Amendments the Specification and to the Claims**

The specification has been amended pursuant to 37 § 1.809 to indicate the extent of public availability regarding *Actinomyces salinospora* strains which are the subject matter of the claimed invention. It is respectfully submitted that the amendments set forth above clarify the extent of public availability of Applicant's deposit statement.

Claims 20, 30 and 32 have been amended per the suggestion of the Examiner on page 2 of the Office Action. The claims have been amended to correct their dependency to a "method" claim (claim 18) and not a composition claim (claim 1).

As such all amendments to the specification are pursuant to 37 CFR § 1.809 (d)(1)-(4) and do not add new matter.

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**II. Rejections under 35 U.S.C. §112, First Paragraph (enablement)**

Claims 1, 17-18, 20 and 25-32 stand rejected under on 35 U.S.C. § 112, first paragraph, as allegedly containing subject matter not described in the specification in such a way as to enable one of skill in the art to make or use the invention. Applicants respectfully traverse the rejection as it applies to the supplemental Declaration of Dr. Jensen enclosed herein.

According to the Office Action, the Declaration of Dr. Jensen which was enclosed with the response filed September 27, 2005 fails to aver that that all restrictions on the availability to the public of the material so deposited will be irrevocably removed upon the granting of a patent (page 2 of the Office Action).

A supplemental Declaration of Dr. Jensen is enclosed herein. The Declaration herein incorporates a paragraph pursuant to 37 CFR § 1.808(a)(2) stating that Applicant, in part, that:

The organisms will be made available by ATCC under the terms of the Budapest Treaty and the line will be irrevocably and without restriction or condition released to the public upon issuance of a patent. Also, If the culture deposit should die or be lost or destroyed when cultivated under suitable conditions, it will be promptly replaced on notification with a viable specimen of the same culture. Availability of a deposited strain is not to be construed as a license to practice the invention in contravention of the rights granted under the authority of any government in accordance with its patent laws. [paragraph 6].

The Declaration does not introduce any new matter.

Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. § 112, first paragraph is respectfully requested.

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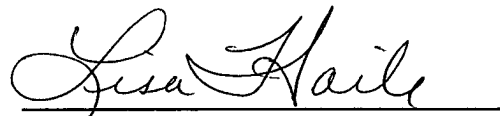
### Conclusion

In view of the amendments and above remarks, it is submitted that the claims are in condition for allowance, and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicant's undersigned representative if there are any questions relating to this application.

No fee is deemed necessary in connection with the filing of this paper. However, the Commissioner is hereby authorized to charge any other fees that may be required by this paper or credit any overpayments to Deposit Account No. 07-1896. A duplicate copy of the Transmittal Sheet is attached.

Respectfully submitted,

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